



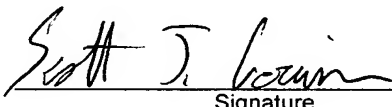
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) E0295.70195US00	
	Application Number 10/762,044-Conf. #4481	Filed January 21, 2004	
	First Named Inventor Stephen J. Todd et al.		
	Art Unit 2161	Examiner E. P. Leroux	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 57,866</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature _____ Scott J. Gerwin Typed or printed name _____ (617) 646-8000 Telephone number _____ February 27, 2007 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ *Total of 1 forms are submitted.

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

To further the prosecution of this application, Applicants request pre-appeal brief review.

Summary of Prosecution of the Application

The first Office Action rejected claims 1-37 under 35 U.S.C. §102(e) or §103(a) over Bazoon (Pub. No. 2004/0249871), either alone or in combination with other references. However, the Office Action did not specify a basis for the rejection of claims 38-80, but asserted that these claims "can be rejected on a similar basis to claims 1-37."

Applicants' October 13, 2006 response explained that the claims distinguish over Bazoon for reasons discussed in detail below. The Examiner then issued a Final Office Action which cut and pasted the prior art rejections from the previous Office Action. The only response to Applicants' arguments indicated that the Examiner found them unpersuasive because he believed that the "features upon which applicant relies are not recited in the claims." *See* Final Office Action, page 9.

It was unclear to Applicants which features the Examiner believed were not recited in the claims, so Applicants scheduled a telephone interview with the Examiner on January 9, 2006. During the interview, the Examiner asserted that because the limitation of claim 1 that recites a retention period as a period during which a content unit cannot be deleted from the storage system is in the preamble of the claim, he was not giving it patentable weight, even though the preamble language provides antecedent basis for the limitations relating to the retention period in the body of the claim. Furthermore, he indicated that even if the claims were amended to move that limitation into the body of the claim, he still believed the claim to be unpatentable over the "storage periods" of Bazoon.

Applicants endeavored to discuss with the Examiner the differences between the claimed retention period and the storage period in the system of Bazoon, but rather than explain why he believes that the claimed retention period reads on the storage period of Bazoon, the Examiner simply indicated that if Applicants wanted to move forward with this application, they would have to appeal.

Applicants considered making an after final amendment to move the limitations of claim 1 (and the other independent claims) that recite a retention period as being a period during which a content unit cannot be deleted from the storage system from the preamble to the body of the claim to narrow the issues for appeal. However, in a quick telephone call on January 10, 2007, the Examiner said that he would not enter such an amendment after final. Thus, Applicants are proceeding with the claims as is.

Overview of Embodiments of the Invention

Applicants have appreciated that it is often important for a business or institution to prevent records from being deleted or modified until a certain period of time has elapsed (specification, page 1, lines 15-17). In one embodiment, a retention period may be assigned to a unit of data stored on a storage system, which specifies a period of time during which the storage system will not permit deletion of the unit of data (specification, page 15, lines 1-12). Thus, if a request to delete the unit of data is received before expiration of the retention period, the request is denied and the unit of data is not deleted.

Applicants also have appreciated that in some situations, it may be desired to reduce the length of a previously defined retention period before that retention period expires (specification, page 20, lines 26-29). Such situations may arise, for example, when an event occurs that may obviate the need to retain the data for the entire length of a previously defined retention period. (e.g., the death of a medical patient may obviate the need to retain the patient's medical records) (specification, page 20, line 29 to page 21, line 1).

Figure 5 conceptually shows one embodiment of the invention in which the retention period for a unit of data may be reduced. In Figure 5, source 501 sends a request 503 to storage system 505. The request 503 seeks to reduce a retention period for a CDF 506 stored in a storage system 505 (specification, page 21, lines 11-14). The retention period is reduced in response, which permits the unit of data to be deleted prior to expiration of its initially specified retention period.

It should be appreciated that the foregoing discussion of embodiments of the invention is provided merely to assist the reviewers in appreciating various aspects of the present invention.

However, not all of the description provided above necessarily applies to each of the independent claims. Therefore, the reviewers are requested to not rely upon the foregoing summary in interpreting any of the claims or in determining whether they patentably distinguish over the prior art of record, but rather are requested to rely only upon the language of the claims themselves and the arguments specifically related thereto provided below.

The Limitation In The Preambles Of Several Independent Claims Directed To Retention Periods Should Be Given Patentable Weight Because It Provides Antecedent Basis For The Retention Periods Recited in the Body Of The Claims

The Examiner indicated that he was not giving patentable weight to the limitation of claim 1 that recites that the at least one CAS system stores “at least one unit of data having a previously-defined retention period during which the at least one unit of data cannot be deleted from the at least one CAS system,” because this limitation is recited in the preamble of claim 1. Applicants believe this is improper, as the reference to “the retention period” in the body of each claim necessarily refers to the retention period referenced in the preamble, and therefore incorporates the limitations on the retention period defined in the preamble.

The Federal Circuit has made clear that limitations in the preamble of a claim are limiting when they are relied upon by limitations in the body of the claim for “antecedent basis,” i.e., where the claim introduces in the preamble a term that is later recited in the claim body. E.g., NTP, Inc. v. Research in Motion, Ltd., 418 F.3d 1282, 1306, 75 USPQ2d 1763, 1781 (Fed. Cir. 2005) (“Because these limitations of claim 1 ... derive their antecedent basis from the claim 1 preamble and are necessary to provide context for the claim limitations, the use of these limitations in the preamble limits the claim.”); Eaton Corp. v. Rockwell Int’l Corp., 323 F.3d 1332, 1339, 66 USPQ2d 1271, 1276 (Fed. Cir. 2003) (“When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed combination.”).

Applying this reasoning to the independent claims makes clear that the limitation in the preambles that recites a retention period as being a “period during which the at least one unit of data cannot be deleted from the at least one CAS system,” should be construed as limiting the scope of claims 1, 20, 39, 58, 65, and 72, because the body of each of these claims refers to the

retention period. Thus, the preambles of those claims provide antecedent basis for limitations in the bodies of the claims and must be construed as limiting.

As should be clear from the foregoing, because the above-discussed limitations of the preambles of the independent claims provide antecedent basis for “the retention period” recited in the bodies of these claims, these preamble limitations should be construed as limiting the scope of the claims.

Bazoon Does Not Disclose Or Suggest The Use Of The Claimed Retention Periods

Bazoon does not disclose or suggest the use of retention periods during which the units of data cannot be deleted from the at least one storage system. Bazoon is directed to a system and method for automatically removing documents from a knowledge repository (Title; Abstract). Bazoon discloses that a storage period may be assigned to a document in the repository and defines a storage period as a value or value range which tracks the amount of time remaining for the document to stay in the repository (§20). That is, a storage period defines a maximum period of time that a document is allowed to exist in the knowledge repository (§20). Thus, when the storage period of a document has expired, the document is automatically removed from the knowledge repository (§24).

Bazoon simply does not disclose the use of a retention period that defines a period during which the at least one unit of data **cannot be deleted from the storage system**. Thus, Bazoon necessarily does not disclose receiving, at a storage system, a request from a host to reduce a length of the retention period for the at least one unit of data and reducing the length of the retention period for the at least one unit of data in response to the request, as recited in claim 1.

During the telephone interview of January 9, 2006, the Examiner acknowledged that Bazoon does not explicitly state that a storage period for a document is a period of time during which the document cannot be deleted. However, he indicated that the use of the term “storage period” necessarily means that a document cannot be deleted during its storage period, despite the absence of any such suggestion in the reference, and despite the fact that the reference describes a storage period explicitly as defining something different, i.e., when a document must be deleted.

In essence, the Examiner appears to be asserting that the term “storage period,” inherently defines a period during which a document cannot be deleted. Such an inherency rejection is improper.

As MPEP §2112 makes clear, the bar is extremely high for establishing an inherency rejection. That is, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” MPEP §2112(IV), page 2100-47 of Original Eighth Edition, Rev. 5, Aug. 2006.

There is simply nothing in Bazoon which suggests that a storage period must define a period during which a document cannot be deleted. Even more strikingly, Bazoon specifically defines a storage period otherwise – i.e., as a period after which a document must be deleted.

Each independent claim recites use of a retention period during which a unit of data cannot be deleted. Thus, each of these claims patentably distinguishes over Bazoon and the rejection of each of these claims is improper.

Incompleteness of Office Action

As discussed above, the Final Office Action does not specify a basis for the rejection of claims 38-80, but asserts that these claims “can be rejected on a similar basis to claims 1-37.” This is improper, as the Final Office Action does not even directly identify any reference(s) relied upon in rejecting claims 38-80 (leaving open to speculation whether these claims are believed to be anticipated by Bazoon), let alone identify or explain the pertinence of any parts of any reference, as required by 37 CFR §1.104(c)(2) and MPEP §707.

Applicants are concerned that in view of the obvious deficiencies in the Final Office Action, the Board might remand the application back the Examiner to provide a proper analysis/rejection of claims 38-80. Such a delay would serve neither the interests of Applicants nor the Patent Office. Thus, it is respectfully requested that if these claims are to continue to be rejected, a new Office Action be issued that meets the requirements of MPEP §707.